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No. 73-1202

In the
Supreme Court of the United States
OCTOBER TERM, 1973

KERMIT H. WILSON and
SICO INCORPORATED,
Petitioners,

vs.

MIDWEST FOLDING PRODUCTS
MANUFACTURING CORP.

and

MIDWEST FOLDING PRODUCTS
SALES CORPORATION,
Respondents.

RESPONSE TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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I. NO CASE OR CONTROVERSY EXISTS BECAUSE THE DECISIONS BELOW OF INVALIDITY AND NON-INFRINGEMENT ARE SUPPORTED BY INDEPENDENT GROUNDS NOT PRESENTED IN THE PETITION.

A. THE "ISSUES" BEFORE THIS COURT.

Petitioners purported to assert three "Questions Presented": the first relating to 35 USC §103, *Graham* v. *John*

Deere, 383 U.S. 1 (1966) and "obviousness"; the second relating to infringement and interpretation of the claims; and the third asking what disposition should be made on appellate review if error is found as to the first two questions.

No other questions are before this court (Supreme Court Rule 23(c)).

Examining the "questions presented", it will be seen that the third question clearly states no reviewable legal issue but only asks rhetorically what relief should be granted, if error is found. Furthermore, it is not supported by facts in the "Statement of the Case" as required by Rules 23(e) and (h).

Regarding the second "question presented", there is absolutely no discussion or factual support therefor in the "Statement of the Case". Thus, it is apparent that only the first question is before this Court.

B. THE JUDGMENT OF THE DISTRICT COURT, AFFIRMED BY THE APPELLATE COURT, FOUND THE CLAIMS IN SUIT INVALID ON A NUMBER OF GROUNDS.

At the outset, it is important to correct a misimpression created by the loose presentation of the petitioners. The lower courts did not hold the *patent* or the *invention* invalid for "obviousness" under 35 USC §103. Instead, they found five of the nine *claims* of the patent invalid for a variety of reasons, all of which are fully supported by the record.

Referring to the Findings of Fact (F) and Conclusions of Law (C), it will be seen that the District Court found:

1. All the claims in suit, Claims 1, 6, 7, 8 and 9 are invalid for indefiniteness (35 USC §112) for failure to

recite an essential element necessary to make the claimed structures operable (F66, C5).

2. Claims 6, 8 and 9 are invalid for indefiniteness (35 USC §112) because they recite inventions other than that described and contemplated in the specification (F 61, 63, 64, 69, 70, 82, C4).

3. Claim 6 is directly anticipated (35 USC §102) by prior art patents not considered by the Patent Office (F60, 62).

In addition to the listed grounds, Claims 1, 6, 7, 8 and 9 were held invalid for obviousness under 35 USC §103, (F42-60, C2), the sole "question presented" to this Court by the petitioners.

Furthermore, the District Court found that the accused structure does not infringe the patent claims in suit (C6, 7). It is worthy of note that this determination was based upon meticulous comparison of structures, methods of operation, and claim language (F9-16, 32-41, 71-84). It is likewise noteworthy that each claim in suit contained at least one "means" limitation and that the District Court properly construed the claim language in accordance with the mandate of 35 USC §112. Obviously, such determination bears no relationship whatever with 35 USC §103 or *Graham* v. *Deere* standards as petitioners apparently are contending.

In view of the foregoing, it is apparent that, even were this Court to accept every proper "question presented" by petitioners, the claims in suit still would be invalid and not infringed if valid. The Petition thus presents no "case or controversy" for this Court to decide. *California* v. *San Pablo & Co. Railroad* 149 US 308, 314 (1893).

II. THE DISTRICT COURT CAREFULLY FOLLOWED THE GRAHAM v. DEERE STANDARDS AND HAD AMPLE FACTUAL SUPPORTS FOR ITS FINDINGS AND CONCLUSIONS OF OBVIOUSNESS IN THE PRIOR ART AND TESTIMONY OF WITNESSES.

Petitioners' entire argument as to the alleged erroneous application of *Graham* v. *Deere* is based on their unsupported statement that defendants failed to introduce any evidence of the level of ordinary skill in the art and the difference between the prior art and the claims at issue. Nothing could be further from the facts.

The record evidence comprises the prior art itself, including uncited prior art which was found to *fully anticipate* claim 6 under §102 (F60, 62) plus testimony in court by at least three persons skilled in the art. Indeed, the evidence proved that some of the pertinent uncited prior art was known to petitioners and previously considered pertinent by their patent attorney-searcher.

The patentee, Wilson, testified in depositions and at the trial as did petitioners' chief engineer, Bue, and their "expert" Clark. Bue was an experienced engineer in the field at the time of the alleged invention, and the patentee Wilson and his "expert" Clark obviously must be considered persons skilled in the art at the time the invention was made. Wilson and Bue were cross-examined extensively as to the background of the development of the device shown in the patent in suit. Wilson, particularly, testified as to the prior art tables with seats, that there were similar folding table units with benches, and that *after customers gave him the idea* of replacing the benches with individual seats, he simply "cut slots in these benches, you might say".

All of these witnesses testified about the pertinent prior art patents and the alleged differences between those structures and the invention in suit. Petitioners' patent expert, attorney Sell, likewise testified in open court and their patent agent Ringswood testified by deposition regarding the prior art.

Petitioners' no-evidence assertion conveniently ignores the fact that the testimony of their own witnesses is evidence in the case even when it supports the defendants' position. For example, we know of no better evidence of non-infringement than the cross-examination and testimony of petitioners' own witnesses, Wilson, Bue and Clark, that the patented and accused devices were different in structure and operated in a different way.

Additionally, respondents' witness, Haunost, testified about his independent development of the accused structure. He is a practical engineer of many years experience, having designed folding bench tables for defendant as early as 1957. He testified, upon direct examination, vigorous cross-examination by petitioners' counsel, and extensive questioning by the District Court itself, that he independently developed the exhibit DX55 solely from the teachings of the Mackintosh patent.

Clearly, the mass of evidence alluded to provides more than ample record support for the District Court's reference in its Memorandum opinion to "examination of the prior art" and "listening to the witnesses skilled in the art" (A 4, 5).

CONCLUSION

The judgment of the District Court, affirmed by the Court of Appeals, is correct in all respects, and petitioners have not presented a proper case or controversy for decision by this Court. The Petition for Writ should be denied.

Respectfully submitted,

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